

### III. Remarks

#### A. Status of the Application

Claims 1-5, 8, 10-12, 14-27, 29-37, 40-41, 44-51, 90-108, 142-146 and 148 are pending. Claims 1, 8, 19, 29-31, 44, 49 and 142 are amended herein. Claims 6-7, 9, 13, 28, 38-39, 42-43, 52-89, 109-141 and 147 have been cancelled. Claim 148 has been added.

Favorable consideration of this application is respectfully requested.

#### B. Allowable Subject Matter

Applicant acknowledges and appreciates the indication that claims 8, 10-12, 14-18 and 90-108 are allowed. Applicant also acknowledges and appreciates the indication that claims 4, 7, 25, 28, 29, 38, 39, 43, 50, 51, 145 and 147 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### C. Claim Amendments

Claims 1, 19, 31 and 142 have been amended to include the subject matter of claims 7, 28, 43 and 147, respectively. Claims 7, 28, 43 and 147 have been cancelled.

Claim 1 has been further amended to delete the requirement that the jacket disposed around the body member be an "elastomeric" jacket.

Claim 8 has been amended to correct grammar errors.

Claim 29 has been amended to depend from claim 19 in view of the cancellation of claim 28.

Claim 30 has been amended so as to provide antecedent basis for the recited subject matter.

Claim 44 has been amended to specify that the claimed apparatus comprises a cementing plug and that the body member of the cementing plug which defines a central opening therethrough also has a plurality of wipers that deflect into substantially cylindrical wiping engagement with the inner surface of a casing when the cementing plug is disposed therein.

Claim 49 has been amended to correct a claim dependency error.

D. Claim Rejection Under 35 U.S.C. §112

Claims 5 and 30 stand rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. As noted above, claim 5 has been cancelled. Also, as noted above, claim 30 has been amended to overcome this rejection.

For the foregoing reasons, it is respectfully requested that the rejection of claims 5 and 30 under 35 U.S.C. §112, second paragraph, be withdrawn.

E. Claim Rejections Under 35 U.S.C. §102

Claims 1-3, 5, 31-37, 40-41, 142-144 and 146 stand rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,242,018 to LaFleur ("LaFleur '018"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As noted above, claims 1, 31 and 142 were amended to include the subject matter of claims 7, 43 and 147, respectively, thereby effectively placing claims 7, 43 and 147 in independent form. Since the Office Action noted that claims 7, 43 and 147 would be allowable if placed in independent form, it is respectfully submitted that claims 1, 31 and 142 and the claims that depend therefrom, namely claims 2-3, 5, 32-37, 40-41, 143-144 and 146 are in condition for allowance.

For the foregoing reasons, it is respectfully requested that the rejection of claims 1-3, 5, 31-37, 40-41, 142-144 and 146 under 35 U.S.C. §102(b) over LaFleur '018 be withdrawn.

Claims 19-24, 26-27 and 30 stand rejected under 35 U.S.C. §102(b) over LaFleur '018. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As noted above, claim 19 was amended to include the subject matter of claim 28, thereby effectively placing claim 28 in independent form. Since the Office Action noted that claim 28 would be allowable if placed in independent form, it is respectfully submitted that claim 19 and the claims that depend therefrom, namely claims 20-24, 26-27 and 30 are in condition for allowance.

For the foregoing reasons, it is respectfully requested that the rejection of claims 19-24, 26-27 and 30 under 35 U.S.C. §102(b) over LaFleur '018 be withdrawn.

F. Claim Rejection Under 35 U.S.C. §103

Claims 44-49 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,226,561 to Hamilton ("Hamilton '561"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

To sustain the present rejection of claims 44-49 under 35 U.S.C. § 103(a) over Hamilton '561, a prima facie case of obviousness must be established. In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741 (emphasis added). As the PTO recognizes in MPEP § 2142:

*...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, a prima facie case of obviousness has not been factually supported for the following reasons.

Claim 44 is drawn to an apparatus comprising a cementing plug which has:

a body member defining a central opening therethrough, the body member having a plurality of wipers that deflect into substantially cylindrical wiping engagement with the inner surface of a casing when the cementing plug is disposed therein; and

an insert positioned for at least temporary closure of the central opening, wherein the insert comprises:

an outer ring portion, and

an inner portion extending from the outer ring portion,

wherein the inner portion is thinner than the outer ring portion and has a variable thickness.

Each of claims 45-49 depends directly or indirectly from claim 44, and therefore each includes at least the foregoing elements.

Hamilton '561 discloses a projectile for releasing a gas or other suitable fluid to initiate operation of an inflator in a motor vehicle inflatable safety system. (Hamilton '561, Abstract). As shown in FIGS. 9-10 of Hamilton '561, the inflatable safety system includes a dome-shaped disk 38 which has a concave side 46 exposed to a gas stored within a gas housing 34 and a convex side 50 positioned to face a projectile 82. While the disk 38 is disclosed to be dome-shaped, the inflatable safety system of Hamilton '561 is not a cementing plug and does not include a body member having a central opening and a plurality of wipers that deflect into substantially cylindrical wiping engagement with the inner surface of a casing when the cementing plug is disposed in a casing.

MPEP § 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in the present matter, it is respectfully submitted that all of the words in claims 44-49 have not been considered. In view of the foregoing, Applicant respectfully submits that Hamilton '561 fails to disclose each and every element of claim 44. Therefore, it is respectfully submitted that the initial burden of factually supporting an alleged prima facie case of obviousness of independent claim 44 under 35 U.S.C. §103(a) over Hamilton '561 has not been met. It is further respectfully submitted that the initial burden of factually supporting an alleged prima facie case of obviousness of dependent claims 45-49 under 35 U.S.C. §103(a) over Hamilton '561 has not been met, for at least the same reasons that apply to claim 44. For the foregoing reasons, Applicant requests that the rejection of claims 44-49 under 35 U.S.C. §103(a) over Hamilton '561 be withdrawn.

G. New Claim 148

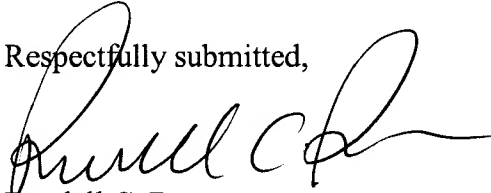
Claim 39 has been placed in independent form and has been added as new claim 148. Since the Office Action noted that claim 39 would be allowable if placed in independent form, it is respectfully submitted that claim 148 is in condition for allowance.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-5, 8, 10-12, 14-27, 29-37, 40-41, 44-51, 90-108, 142-146 and 148 are in condition for allowance and an early formal notice thereof is requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Randall C. Brown', with a stylized flourish extending to the right.

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